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10/730,244	12/08/2003	Stephen C. Tulley	00-019-C1	2482

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EXAMINER	
LEIVA, FRANK M	
ART UNIT	PAPER NUMBER
3714	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/730,244	TULLEY ET AL.	
	Examiner	Art Unit	
	FRANK M. LEIVA	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *16 December 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *48,52-65,68-74,76 and 77* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *48,52-65,69,73,74,76 and 77* is/are rejected.

7)☒ Claim(s) *68 and 70-72* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Acknowledgements

1. The examiner acknowledges amendments to claims 48, 52, 54, 57-58, 63-64, 68 and 73-74 and cancellation of claim 75 in applicant's submission filed 29 July 2008. Examiner also acknowledges Terminal Disclaimer for US Patent number 6,688,976, filed 06 March 2006, yet fails to find Terminal Disclaimers requested for the applications below.

Response to Arguments

2. Applicant's arguments filed 29 July 2008 have been fully considered but they are not persuasive. Claim 48 is still rejected in view of Double patent rejections. In regards of amended claims 52, 54, 57-58, 63-64 and 73-75; arguments are directed to the amended limitations and covered in the rejections below.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29

USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 48, 52-65 and 68-75 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 56-124 of copending **Application No. 11/424155**. Although the conflicting claims are not identical, they are not patentably distinct from each other because although all the limitations of the copending application are listed within the dependent claims and covered by the entire claimed invention of the present application.

5. Claims 48, 52-65 and 68-75 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 56-145 of copending **Application No. 11/424162**. Although the conflicting claims are not identical, they are not patentably distinct from each other because although all the limitations of the copending application are listed within the dependent claims and covered by the entire claimed invention of the present application.

6. Claims 48, 52-65 and 68-75 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 56-122 of copending **Application No. 11/424166**. Although the conflicting claims are not identical, they are not patentably distinct from each other because although all the limitations of the copending application are listed within the dependent claims and covered by the entire claimed invention of the present application.

7. Claims 48, 52-65 and 68-75 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 56-78 of copending **Application No. 11/531735**. Although the conflicting claims are not identical, they are not patentably distinct from each other because although all the limitations of the copending application are listed within the dependent claims and covered by the entire claimed invention of the present application.

8. Claims 48, 52-65 and 68-75 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 56-71 of copending **Application No. 11/531741**. Although the conflicting claims are not identical, they are not patentably distinct from each other because although all the limitations of the copending application are listed within the dependent claims and covered by the entire claimed invention of the present application.

9. Claims 48, 52-65 and 68-75 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 56-72 of copending **Application No. 11/531744**. Although the conflicting claims are not identical, they are not patentably distinct from each other because although all the limitations of the copending application are listed within the dependent claims and covered by the entire claimed invention of the present application.

10. Claims 48, 52-65 and 68-75 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 56-72 of copending **Application No. 11/531749**. Although the conflicting claims are not identical, they are not patentably distinct from each other because although all the limitations of the copending application are listed within the dependent claims and covered by the entire claimed invention of the present application.

11. Claims 48, 52-65 and 68-75 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 56-90 of copending **Application No. 11/531754**. Although the conflicting claims are not identical, they are not patentably distinct from each other because although all the limitations of the copending application are listed within the dependent claims and covered by the entire claimed invention of the present application.

12. These are provisional obviousness-type double patenting rejections because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> a. A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

14. Claims 48, 52-65, 69, 73-74 and 76-77 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Scanlon (US 4,922,522).

15. Regarding claim 48; Scanlon discloses a method of facilitating a lottery ticket transaction, comprising receiving, by a lottery device, a request by a player to purchase a lottery ticket for a lottery drawing, wherein the lottery ticket is assigned a lottery number combination, (col. 2:57-63); determining, by the lottery device, whether a request has been made by the player that the lottery number combination be exclusively assigned to only a single lottery ticket for the lottery drawing, such that the lottery number combination will not be assigned to any other lottery ticket purchased for the lottery drawing, (col. 5:49-55), wherein the system determines that the lottery combination was not entered before and will prohibit the creation of any duplicates (alternatively); performing, by the lottery device, (a) if a request that the lottery number combination be exclusively assigned to only a single lottery ticket has been made by the player, in response to the request by the player that the lottery number combination be exclusively assigned to only a single lottery ticket for the lottery drawing, determining the lottery number combination such that the lottery number combination is exclusively

assigned to only a single lottery ticket for the lottery drawing, in which determining the lottery number combination comprises using a random process to select at least one number of the lottery number combination; and preventing the lottery number combination from being assigned to at least one additional lottery ticket for the lottery drawing, (col. 5:18-33, 5:49-56, and 4:24-32); or

(b) if a request that the lottery number combination be exclusively assigned to only a single lottery ticket has not been made by the player, determining the lottery number combination such that it is possible that at the time of the lottery drawing the lottery number combination could be assigned to more than one lottery ticket for the lottery drawing, (col. 4:21-24 and 5:18-56), wherein the embodiment does not prohibit duplication, then the player can review the number combinations and select his/her combination without limitation of duplication; and

outputting, by the lottery device, an indication of the lottery number combination determined, (col. 5:57-65) printed output of the ticket.

It should be understood that all limitations of claim 48 are covered by Scanlon yet in an ambiguous manner and that although inherent in the disclosure it would also surely be obvious to one of ordinary skill in the art to interpret the embodiments as such, and that no motivation to combine is necessary since arts have not been combined.

16. Regarding claims 52, 73-74 and 76-77; Scanlon discloses a method of facilitating a lottery ticket transaction, the lottery ticket being associated with a lottery number combination, comprising: receiving, by a controller and from a lottery terminal a request to purchase a lottery ticket for a lottery drawing, (col. 2:57-63); determining whether a request has been made by the player that the lottery number combination be exclusively assigned to no more than a predetermined number of lottery tickets sold with respect to the drawing, (col.5:18-33), wherein the predetermined number is a set number by the system and known to the player upon purchase;

if a request that the lottery number combination be exclusively associated with only a single lottery ticket has been made by the player, in response to the request by the player that the lottery number combination be exclusively associated with only a

single lottery ticket for the lottery drawing, determining, by the controller, the lottery number combination such that the lottery number combination is exclusively associated with only a single lottery ticket for the lottery drawing, in which determining the lottery number combination comprises using a random process to select at least one number of the lottery number combination; and preventing the lottery number combination from being associated with at least one additional lottery ticket for the lottery drawing, (col. 5:18-33 and 5:53-55) where the player can query if the number selection has been duplicated in another ticket and the system can be program to prohibit such duplicate tickets.

if a request that the lottery number combination be exclusively associated with only a single lottery ticket has not been made by the player, determining the lottery number combination such that it is possible that at the time of the lottery drawing the lottery number combination could be associated with more than one lottery ticket for the lottery drawing, (col. 5:18-33); and outputting an indication of the lottery number combination determined according to either (a) or (b), (col. 5:62-65); wherein no more than one of the predetermined number of lottery tickets is purchase by the player, (col. 5:49-53).

17. Regarding claim 53; Scanlon discloses wherein the predetermined number of lottery tickets is one lottery ticket, (col. 5:53-55).

18. Regarding claim 54; Scanlon discloses further comprising: preventing at least one lottery ticket from being associated with the determined set of symbols, (col. 5:53-55).

19. Regarding claim 55; Scanlon discloses further comprising: determining a lottery ticket identifier, (col. 5:56-65).

20. Regarding claim 56; Scanlon discloses further comprising: transmitting an indication of the lottery ticket identifier to the lottery terminal, (col. 5:56-65).

21. Regarding claim 57; Scanlon discloses wherein determining the set of symbols comprises: determining a set of symbols that has not previously been associated with any lottery ticket with respect to the drawing, (col. 5:18-33) where the process of selecting numbers is followed by a search for duplicate number selections and allowing the user to cancel and select another set.

22. Regarding claim 58; Scanlon discloses further comprising: preventing at least one lottery ticket from being associated with the determined set of symbols, (col. 5:53-55).

23. Regarding claim 59; Scanlon discloses further comprising: storing an indication of a price for the lottery ticket, (col. 2:57-63) the billing process.

24. Regarding claim 60; Scanlon discloses further comprising: determining the price based on the predetermined number of lottery tickets, (col. 2:57-63) the billing process.

25. Regarding claim 61; Scanlon discloses further comprising: determining the price based on the received indication, (col. 2:57-63).

26. Regarding claim 62; Scanlon discloses wherein determining the set of symbols comprises: randomly determining the set of symbols, (col. 4:21-24).

27. Regarding claim 63; Scanlon discloses further comprising: verifying that the randomly determined set of symbols has not previously been associated with at least one other lottery ticket for the drawing, (col. 5:18-33).

28. Regarding claim 64; Scanlon discloses further comprising: preventing at least one lottery ticket from being associated with the randomly determined set of symbols, (col. 5:53-55).

29. **Regarding claim 65;** Scanlon discloses further comprising: printing a lottery ticket that includes the determined set of symbols, (5:56-65).

30. **Regarding claim 69;** Scanlon discloses in which the predetermined number is not selected by a lottery authority, (col. 4:21-24), where the system allows for both manual and automatic selection of numbers.

31. **Examiner's Note:** Examiner has cited paragraphs and figures in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Allowable Subject Matter

32. Claims 68 and 70-72 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

33. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to FRANK M. LEIVA whose telephone number is (571)272-2460. The examiner can normally be reached on M-Th 9:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter D. Vo can be reached on (571) 272-4690. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

FML
05/22/2009
/Peter D. Vo/
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